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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,026	03/21/2006	Colin John Davies	U 015679-6	8990
140	7590	07/29/2008		
LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023			EXAMINER HUYNH, SON P	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 07/29/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/529,026

**Applicant(s)**

DAVIES, COLIN JOHN

**Examiner**

SON P. HUYNH

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-68 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 30-68 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)  
3) ☒ Information Disclosure Statement(s) (PTO/SE-08)  
Paper No(s)/Mail Date 3/21/06.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Preliminary Amendment filed 10/24/2006 has been entered. Claims 1-29 have been cancelled; claims 30-68 have been amended and/or added.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 52-60, 68 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 52-60,68 recite a pre-recorded medium or a message embedder is directed to non-statutory subject matter because the data in the pre-recorded medium does not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized, and is thus not statutory.

### ***Claim Rejections - 35 USC § 102***

Art Unit: 2623

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 30-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Plotnick et al. (US 2002/0144262).

Regarding claim 30, Plotnick discloses a method for embedding a message (message and/or I frame of alternative data) in compressed content comprising at least one key frame (I frame) and at least one non-key frame (P frame or B frame) – figures 15-17), the method comprising:

embedding a message substantially only in one or more key frames, thereby causing the embedded message to be visible only when the compressed content is played back using trick mode playback (interpreted as embedding/inserting a message include frame/information of alternative advertisement substantially in one or more key frames, and when advertisement/content is fast forwarded/skipped, the alternative ad/message is displayed - see include, but are not limited to, figures 15-17, paragraphs 0094, 0101, 0183, 0201, 0210, 0215, 0221).

Regarding claim 31, Plotnick discloses the method as discussed in the rejection of claim 30. Plotnick further discloses the at least one key frame comprises a plurality of key frames (see key frames 1602, 1604, 1606, 1608, 1610 - figures 16a-16c).

Regarding claim 32, Plotnick discloses the method as discussed in the rejection of claim 31. Plotnick further discloses the embedding comprises embedding the message in each of the plurality of key frames (e.g., alternative advertisements 1620, 1640 - figures 16a-16c).

Regarding claim 33, Plotnick discloses the method as discussed in the rejection of claim 31. Plotnick further discloses the embedding comprises embedding the message in only some of the plurality of key frames (e.g. alternative advertisements 1600, 1630, etc. figures 16a-16c).

Regarding claim 34, Plotnick discloses the method as discussed in the rejection of claim 30. Plotnick further discloses the content is compressed (e.g., MPEG – see include, but are not limited to, paragraphs 0107, 0137, 0204). Thus, the content is provided as non-compressed content before it is produced into compressed content.

Plotnick further discloses producing comprises the embedding (e.g., embedding I frame/message of the alternative content - see include, but are not limited to, figures 4, 6a-6c, 8, 11-17).

Regarding claim 35, Plotnick discloses the method as discussed in the rejection of claim 30. Plotnick further discloses providing the compressed content (e.g., MPEG - figures 11-17), wherein the embedding comprises: identifying the at least one key frame

Art Unit: 2623

(identify the I frame in the MPEG) and embedding the message in the at least one identified key frame (e.g., embedding I frame/message for alternative advertisement - see include, but are not limited to, figures 11-17).

Regarding claim 36, Plotnick discloses the method as discussed in the rejection of claim 30. Plotnick further discloses distributing a stream of compressed content onto a storage medium of an end user unit, the compressed content comprising a plurality of key frames, wherein each individual key frame comprises the embedded message (distributing MPEP stream for storing in storage of PVR/set top box, the content comprises a plurality of I frames wherein each individual I frame comprises message/I frame for alternative advertisement - see include, but are not limited to, paragraphs 0122, 0125, 0126, 0128-0130, 01390147, 0173-0174, figures 10-17).

Regarding claim 37, Plotnick discloses the method as discussed in the rejection of claim 36. Plotnick further discloses the storage medium comprises a removable storage medium (e.g., CD, DVD, standalone PVR, memory sticks, etc., paragraphs 0091, 0105, 0109).

Regarding claim 38, Plotnick discloses the method as discussed in the rejection of claim 36. Plotnick further discloses the storage medium is external to the end user unit (e.g., at the head end or standalone unit in other location – see include, but are not limited to, paragraphs 0064, 0097, 0105, 0121-0122, 0215).

Regarding claim 39, Plotnick discloses the method as discussed in the rejection of claim 36. Plotnick further discloses the storage medium comprises a pre-recorded medium (e.g., VCR, PVR, DVD, etc. - see include, but are not limited to, paragraphs 0091, 0105, 0109, 0121-0122).

Regarding claim 40, Plotnick discloses the method as discussed in the rejection of claim 34. Plotnick further discloses the compressed content is compressed with MPEG-2 compression (see include, but are not limited to, paragraphs 0173, 0178, 0207).

Regarding claim 41, Plotnick discloses the method as discussed in the rejection of claim 40. Plotnick further discloses the key frame comprises an I-frame (figures 16a-16c, paragraphs 0205-0210).

Regarding claim 42, Plotnick discloses the method as discussed in the rejection of claim 41. Plotnick further discloses the embedded message comprises a text message (e.g., added text see include, but are not limited to, paragraphs 0094, 0129, 0136, 0142, 0215).

Regarding claim 43, Plotnick discloses the method as discussed in the rejection of claim 42. Plotnick further discloses the embedded message comprises a graphic element

Art Unit: 2623

(e.g., still image, or logo - see include, but are not limited to, figures 15-17, paragraphs 0059, 0060, 0063).

Regarding claim 44, Plotnick discloses a message delivery method comprising:

receiving, at a consumer device, compressed content, the compressed content comprising a plurality of video frames, the video frames comprising a plurality of key frames and a plurality of non-key frames, substantially only one or more of the plurality of key frames comprising an embedded message (receiving, at a consumer device such as set top box, MPEG compressed content, the MPEP compressed content comprises a plurality of I frames, B frames, P frames; at least some of I frames comprising a embedded message/I frame for alternative advertisements - see include, but are not limited to, figures 10-17 and discussed in the rejection of claim 30);

selecting at least one of the plurality of key frames from the compressed content, thereby producing at least one selected key frame, the embedded message being comprised in the at least one selected key frame (selecting at least one of the I frames from the MPEG compressed content, thereby producing at least one selected I frame including embedded message/key frame for alternative advertisement or brief description of the advertisement - see include, but are not limited to, figures 10-17 and discussion in the rejection of claim 30);

producing non-compressed content from the selected at least one of the plurality of key frames (e.g., decoding/decompressing from the selected at least one of the



plurality of key frames from MPEG compressed content - see include, but are not limited to, paragraphs 0107, 0109, 0129, 0135, 0183);

outputting the non-compressed content comprising the embedded message, wherein the embedded message is visible only when the compressed content is played back using trick mode playback (outputting message, brief description, or I frame of alternative advertisement for display on the screen when the user fast forward/skip the advertisement/content - see figures 11-17 and discussion in the rejection of claim 30).

Regarding claim 45, Plotnick discloses the method as discussed in the rejection of claim 44. Plotnick further discloses the plurality of video frames is received from a broadcast video stream (see include, but are not limited to, paragraphs 0091-0092, 0107, figure 3).

Regarding claim 46, Plotnick discloses the method as discussed in the rejection of claim 44. Plotnick further discloses the plurality of video frames is received from a digital recording (e.g., DVD, PVR, see include, but are not limited to, paragraphs 0091, 0097, 0122, 0172-0174).

Regarding claim 47, Plotnick discloses the method as discussed in the rejection of claim 46. Plotnick further discloses the digital recording is pre-recorded on a medium (e.g., DVD, PVR, memory sticks, etc. - see paragraphs 0091, 0093, 0109, 0172-0174).

Art Unit: 2623

Regarding claims 48, 50-51, the additional limitations as claimed correspond to the additional limitations of claimed in claims 40, 42-43, and are analyzed as discussed in the rejection of claims 40, 42-43.

Regarding claim 49, Plotnick discloses the method as discussed in the rejection of claim 44. Plotnick discloses the plurality of key frames comprising an embedded message comprises a plurality of I frames (figures 16a-17).

Regarding claim 52, the limitations of the pre-recorded medium correspond to the limitations of the method of claim 30 are analyzed as discussed in the rejection of claim 30, wherein the pre-recorded medium is interpreted as DVD, PVR or memory sticks, etc. that records the content (see discussion in the rejection of claim 39).

Regarding claim 53, Plotnick further discloses the embedded message is embedded substantially only in the at least one key frame (figures 16a-17 and discussed in the rejection of claim 30).

Regarding claim 54, Plotnick further discloses the at least one key frames comprising and embedded message comprises a plurality of key frames (see include, but are not limited to, figures 16a-17).

Art Unit: 2623

Regarding claims 55-56, 58-59, the additional limitations that correspond to the additional limitations of claims 40-43 are analyzed as discussed in the rejections of claims 40-43.

Regarding claim 57, Plotnick discloses the pre-recorded medium as discussed in the rejection of claim 52. Plotnick further discloses the medium comprise a DVD (paragraphs 0091, 0172).

Regarding claim 60, the limitations of the message embedder that correspond to the limitations of the method of claim 30 are analyzed as discussed in the rejection of claim 30.

Regarding claim 61, the limitations that correspond to the limitations of claims 30 and 44 are analyzed as discussed in the rejection of claims 30 and 44.

Regarding claim 62, the limitations of the apparatus correspond to the limitations of the method of claim 61 and are analyzed as discussed in the rejection of claim 61.

Regarding claims 63-64, the limitations of the apparatus correspond to the limitations of the method of claim 44 and are analyzed as discussed in the rejection of claim 44.

Art Unit: 2623

Regarding claim 65, the limitations correspond to the limitations of claim 61 are analyzed as discussed in the rejection of claim 61.

Regarding claims 66-68, Plotnick further discloses the compressed content is compressed with MPEG-4 compression (paragraph 0173).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Unger (US 6,909,837 B1) discloses method and system for providing alternative, less-intrusive advertisement that appears during fast forward playback of a recorded video program.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SON P. HUYNH whose telephone number is (571)272-7295. The examiner can normally be reached on 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son P Huynh/  
Primary Examiner, Art Unit 2623

July 14, 2008